

Amendment and Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure

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Serial No.: 09/759,986

Confirmation No.: 3145

Filed: 12 January 2001

For: MULTI-COMPONENT UNIDIRECTIONAL GRAPHIC ARTICLE

### Remarks

The Final Office Action of 1 July 2003 has been received and reviewed. With claims 1, 6, 8, 12, 16, 22, 31, and 34 having been amended, and no claims having been added or canceled, the pending claims remain claims 1-24 and 31-35. Applicants traverse all arguments presented by the Office Action and request reconsideration and withdrawal of the rejections for at least the reasons set forth below.

### Obviousness-Type Double Patenting Rejection

Claims 1-24 and 31-35 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-40 of U.S. Patent Application No. 09/098,702. Applicants defer addressing this provisional rejection until otherwise allowable subject matter is indicated in the present application.

### The 35 U.S.C. §112, First Paragraph, Rejection

Claims 1-24 and 31-35 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the relevant art to which it pertains to make and/or use the invention. Specifically, the Examiner alleges that the word "scrim" in the specification defines it away from the standard definition of scrim, which is a porous sheet.

Applicants maintain that the word scrim is entirely proper as its definition is clear from the specification as originally filed (*see, e.g.*, Specification, page 9, lines 27-28; and page 10, lines 1-2 ("The scrim layer 30 may be any continuous, polymeric film"). "Applicant may be his or her own lexicographer . . . Any special meaning assigned to a term 'must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.'" M.P.E.P. § 2111.01 (citing *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998)).

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As the usage of the term "scrim" is so well understood from Applicants' specification, one of skill in the art would have no trouble understanding the invention. For this reason alone, Applicants submit that the Office's refusal to consider Applicants' definition of the term "scrim" is improper and should be withdrawn. Accordingly, Applicants' previous arguments (including those presented via declaration) warrant full consideration, contrary the assertions of the Office Action.

Nonetheless, in an effort to move this application forward, Applicants have amended claims 1, 6, 8, 12, 16, 22, 31, and 34 to remove the term "scrim." The claims now recite "a substantially transparent, continuous layer/polymeric layer." Such an amendment finds clear support in the specification as originally filed (*see, e.g.*, page 9, lines 27-28 ("The attachment component 14 includes a substantially transparent and un-perforated scrim layer 30"); page 10, lines 1-2 ("The scrim layer 30 may be any continuous, polymeric film"; and figures). As a result, no new matter is introduced. Moreover, as Applicants are amending the claims merely to explicitly recite what was already implicit in the claims, these amendments do not narrow the scope of the identified claims in any way.

As the amended claims no longer include the term "scrim," the 35 U.S.C. §112, first paragraph, rejection is rendered moot.

Applicants further submit that, because the amendments are merely importing a definition into the claims that has been presented previously in the prosecution history, consideration of this amendment will not place an undue burden on the Examiner.

For at least the reasons identified above, entry and consideration of the amendment to claims 1, 6, 8, 12, 16, 22, 31, and 34 are respectfully requested.

#### **The 35 U.S.C. §103 Rejection**

Claims 1-24 and 31-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Andriash (U.S. Patent No. 5,679,435) in view of Bull (WO No. 97/43128). Applicants traverse this rejection and submit that Applicants' previous arguments (including those provided

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in the declarations of 17 April 2001 and 20 March 2003) – which are incorporated by reference herein – are applicable and sufficient to overcome the rejection, an argument only further strengthened by the amendments made herein.

For instance, it is again submitted that the combination of Andriash and Bull fails to render claims 1-24 and 31-35 obvious as the documents fail to teach each and every element of the claimed invention, e.g., no teaching is identified of an attachment component having a continuous layer/polymeric layer between a pressure sensitive adhesive and a hot melt adhesive as recited in the claims.

Applicants also note that, while not clearly understood in the context of the prosecution history, the Office Action's assertion that a porous scrim layer would allow adhesive to "pass therethrough" (*see* present Office Action, page 3) is clearly overcome by the recitation of the continuous polymeric layer in each of the amended independent claims.

As a result, reconsideration and allowance of the claims over Andriash in view of Bull are respectfully requested.

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It is submitted that pending claims 1-24 and 31-35 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for  
Sally J. BULL et al.

By  
Mueting, Raasch & Gebhardt, P.A.  
P.O. Box 581415  
Minneapolis, MN 55458-1415  
Phone: (612) 305-1220  
Facsimile: (612) 305-1228

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Date

By: Matthew W. Adams  
Matthew W. Adams  
Reg. No. 43,459  
Direct Dial (612) 305-1227

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**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Mail Stop AF, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1<sup>st</sup> day of October 2003, at 2:10 p.m. (Central Time).

By: Rachel Gagliardi-Graham  
Name: Rachel Gagliardi-Graham